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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,045	06/14/2001	Kyoko Kimpara	Q64919	5944

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/880,045	KIMPARA ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-7 and 9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-7 and 9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/22/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-2 and 8 have been canceled. Claims 3-4, 6 and 9 have been amended. Claims 3-7 and 9 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (US 6,330,529) in view of Tso et al. (US 6,421,733) and further in view of Furst (US 6,297,819) and further in view of Yates et al. (US 6,330,586).

Claim 3. Ito teaches a mark-up language grammar based translation system and method, comprising: An information providing apparatuses (column 3, lines 57-60); a contents server to store contents provided by a contents provider (column 3, lines 57-60); a user terminal to be operated by a user (column 3, lines 60-63); and a translation computer system (column 4, lines 8-25).

Ito does not teach that said contents provider is charged a conversion fee for contents conversion performed by said conversion server. Also, Ito does not teach showing a method of charging for conversion of said contents; registering said contents information and contents provider information; and collecting use history information for determining said conversion fee.

Tso et al. teach a system and method for dynamically transcoding data transmitted between computers, wherein a Web-page content is translated to a user's native language (column 8, lines 42-43); and wherein a Web-site provider

(owner) pays a proxy provider to improve the performance of all users while visiting the provider's (owner's) site (column 16, lines 36-38). Tso et al. do not teach showing a method of charging for conversion of said contents; registering said contents information and contents provider information; and collecting use history information for determining said conversion fee.

Furst teaches a system and method for translating a Web-page from its native language into a desired language (column 11, lines 65-67), wherein service providers are registered with the system (column 6, lines 52-55), and wherein payment options (subscription information) is shown on a display (column 10, lines 26-28). Furthermore, displaying said information in a rectangular window obviously indicates displaying said information in a banner-type window.

Yates et al. teach a system and method for service provision by means of communications networks, wherein usage record and accrued charges are monitored (column 19, lines 49-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito to include that said contents provider is charged a fee for contents conversion performed by said translation computer system, as disclosed in Tso et al., because it would increase the amount of potential (foreign-speaking) customers for said content provider, and generate funds for an owner of said translation computer system, which (funds) are necessary to operate the business. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito in view of Tso et al. to include registering service providers with the system as taught by Furst, because it would allow to keep record of services offered as subscription for the users. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Ito in view of Tso et al. and further in view of Furst to include monitoring of usage record, as taught by Yates et al., because it would allow to provide discounts for

said subscriptions to the most frequent users thereby stimulating the users to increase their usage time and profits to the system owners.

Claim 4. See **claim 3.**

Claim 5. Tso et al. teach said system and method, wherein, in said conversion said contents, when being described in a foreign language, are translated into contents described in a native language of a user (column 8, lines 42-43). The motivation to combine Ito and Tso et al. would be to increase the amount of potential (foreign-speaking) customers for said content provider, thereby generate more revenue.

Claim 6. See **claim 3.**

Claim 7. Tso et al. teach said system and method, wherein, in said conversion said contents, when being described in a foreign language, are translated into contents described in a native language of a user (column 8, lines 42-43). The motivation to combine Ito and Tso et al. would be to increase the amount of potential (foreign-speaking) customers for said content provider, thereby generate more revenue.

Claim 9. See **claim 3.**

Response to Arguments

Applicant's arguments filed 6/14/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art does not teach a translation instruction banner, it is noted that Furst teaches showing subscription related information on a display (column 10, lines 26-28). Furthermore, Furst teaches displaying said information in a rectangular window (Fig. 1). A banner is a generally square or rectangular boxes provided with some combination of graphics, color and text. Displaying information in a rectangular window in Furst obviously indicates displaying said information in a banner-type window. Information as to the *specific content* of displayed information is non-functional

language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

In response to applicant's argument that there is no suggestion to combine Ito and Tso et al., the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both Ito and Tso et al. relate to data communication between computers over a network, wherein said data is modified. The mark-up language grammar based translation system, disclosed in Ito, would benefit from native language converting system, disclosed in Tso et al., by attracting foreign-speaking customers from all over the world (the Internet), thereby potentially increase revenue.

In response to applicant's argument that there is no suggestion to combine Ito and Tso et al. and Furst, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837

F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, all references relate to data communication between computers over a network, wherein said data is modified. The service providing system, disclosed in Ito in view of Tso et al., would benefit from service registration system, disclosed in Furst, by allowing to keep record of services offered as subscription for the users, thereby enhancing an accounting practice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

9/11/2004

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
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